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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,440	08/24/2004	Eberhard Ammermann	3165-107	2309
6449 7590 08/27/2010 ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005				
EXAMINER				
PURDY, KYLE A				
ART UNIT		PAPER NUMBER		
1611				
NOTIFICATION DATE		DELIVERY MODE		
08/27/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary

Application No.

10/505,440

Applicant(s)

AMMERMANN ET AL.

Examiner

Kyle Purdy

Art Unit

1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8, 9 and 11-16 is/are pending in the application.
- 4a) Of the above claim(s) 3, 4, 8, 9 and 12-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 11 and 15-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/2/2010 has been entered.

Status of Application

2. The Examiner acknowledges receipt of the amendments filed on 6/2/2010 wherein claim 16 has been newly added.

3. Claims 1, 2, 11 and 15-16 are presented for examination on the merits. The following rejections are made.

Response to Applicants' Arguments

4. Applicants arguments filed 6/2/2010 regarding the rejection of claims 1, 2, 11 and 14 made by the Examiner under 35 USC 103(a) over Wachendorff et al. (US 6787567) have been fully considered and they are found persuasive. Applicants argument that according to Wachendorff there is no immediate motivation to combine prothioconazole and trifloxystrobin from the list provided. Further, it's noted that claims 14 is withdrawn as being directed to nonelected subject matter.

5. Applicants arguments filed 6/2/2010 regarding the rejection of claim 15 made by the Examiner under 35 USC 103(a) over Dutzmann et al. (WO 98/47367), evidenced by English equivalent US 6306850 in view of Duvert et al. (WO 00/47047), evidenced by English

equivalent US 6797301 have been fully considered and are **MAINTAINED** for the reasons of record in the office action mailed on 12/03/2009.

6. In regards to the 103(a) rejection, Applicant asserts the following:

A) Relying on Duvert in improper for the showing of azoxystrobin as being functionally equivalent to trifloxystrobin.

7. In response to A, the Examiner disputes the allegation of impropriety. Rather, the Examiner asserts that contrary to Applicants assertion, the Duvert does provide sufficient evidence for one to believe/expect azoxystrobin to be functionally equivalent to trifloxystrobin. In order to rely on equivalence, equivalency must be recognized in the prior art. In the instant case, equivalency is properly established as Duvert teaches that both azoxystrobin and trifloxystrobin have similar biochemical functions, i.e. useful in inhibiting mitochondrial respiration in fungi. Moreover, both compounds are substantially similar in structure. Thus, these two facts provide strong evidence of obviousness in substituting one for the other in a composition as inhibitor of mitochondrial respiration. With respect to synergism, one would expect that since the azoxystrobin and trifloxystrobin are functionally equivalent, substitution of one for the other in combination with prothioconazole would result in a formulation with properties similar to that of the original composition. Applicant argument is not persuasive.

Maintained Rejection (of record, claim 15) and New Rejections (claims 1, 2, 11 and 16)
Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 2, 11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutzmann et al. (WO 98/47367; of record, see IDS 08/24/2004), evidenced by English equivalent, US 6306850 (see IDS 08/24/2004) in view of Duvert et al. (WO 00/47047), evidenced by English equivalent, US 6797301.

10. Dutzmann is directed to novel active combinations of prothioconazole and azoxystrobin (see Table 1, column 25). Dutzmann teaches that prothioconazole and azoxystrobin can be synergistic in a weight ratio of 1:5. Table 1 shows that combinations of prothioconazole and azoxystrobin possess synergistic benefit. Dutzmann teaches that synergism can be achieved wherein the triazole and the strobilurin are employed at a weight ratio from 0.1:50, preferably from 0.2:20 (see column 12, lines 40-45).

11. Dutzmann fails to teach the composition as comprising/consisting of prothioconazole and trifloxystrobin.

12. Duvert teaches that strobilurin fungicides like azoxystrobin and trifloxystrobin are functionally equivalent for their ability to inhibit mitochondrial respiration in fungi and causing them to die (see column 2, lines 35-35).

13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Dutzmann with Duvert with a reasonable expectation for success in arriving at a composition consisting of prothioconazole and trifloxystrobin. It would have been within the purview of an ordinary person to use trifloxystrobin in place of azoxystrobin because both compounds are recognized in the art as having similar biological activities, i.e. inhibiting mitochondrial respiration. In order to rely on

equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art. In the instant case, one would consider trifloxystrobin to be a functional equivalent to azoxystrobin for at least two reasons. The first is that the compounds are structurally related, that is they both belong to the same class of compounds. Second, both compounds are recognized by the art to exert the same effect in biological systems, i.e. inhibition of mitochondrial respiration. Therefore, one would readily envisage substituting trifloxystrobin with azoxystrobin with a reasonable expectation for success in providing a fungicidal composition with synergistic properties. Therefore, the invention as a whole is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Kyle Purdy/

Examiner, Art Unit 1611

August 23, 2010

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611